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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,617

04/12/2004

Mark A. Weiss

10379-6U2

3288

570 7590 01/24/2007  
AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

LETT, THOMAS J

ART UNIT

PAPER NUMBER

2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/822,617

Applicant(s)

WEISS, MARK A.

Examiner

Thomas J. Lett

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 02 November 2006 have been fully considered but they are not persuasive.
2. Regarding the 35 USC § 101 claim rejections, Applicant argues using the case law (In re Gulack) as contained in Annex IV of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility". Annex IV relates to Computer-Related Nonstatutory Subject Matter (see page 50) and the decision of Gulack is based on a 103 prior art rejection, not a 101 non-statutory rejection.

Applicant is asked to review 706.03(a) of the MPEP, which states: a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes.

3. Regarding the 35 USC § 102(b) claim rejection of claim 1, Applicant argues that the prior art of Seymour (USPN 5,967,050) does not disclose or suggest element (a) of the proofing paper and does not disclose or suggest proofing paper having a blank region for subsequent printing of a content image portion, and actually teaches away from this claim limitation. Examiner responds that all paper, plates, or substrates inherently have a blank area that will subsequently have ink applied (the ink can be for image(s), text, etc.) – this is inherent, and reads on the claim even if Applicant did not intend to claim in that fashion. In addition, Seymour teaches of a trim area (margin, which is usually blank) where a color bar may be printed (col. 2, lines 10-12). Further,

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the blank regions are not clearly defined (in the specification) to enable one of ordinary skill in the art to clearly determine the boundaries of these regions.

4. Regarding the 35 USC § 102(b) claim rejection of claim 3, Applicant argues that Seymour does not disclose or suggest element (c) one or more second color bars printed along with the content image portion and printed in a predefined relationship to the one or more first color bars. Examiner responds that the patches are the building blocks of a color bar. There is no requirement for a color bar to have a certain amount of patches. The Examiner reads a patch to be a color bar and one or more patches in Seymour has a predefined relationship to the one color bar of Seymour et al.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 3 and their dependencies are directed to proofing paper or a hard proof which are per se not statutory. Data that is pre-printed in certain regions of a page is merely text or image(s) ("a mere arrangement of printed matter"), and the combination does not impart patentable subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Seymour (USPN 5,967,050).

**Regarding claim 1:** Seymour teaches proofing (the printed image of a color bar, column 7, lines 10-15, column 7, lines 20-32, column 2, lines 5- 10) paper (column 1, line 21) comprising:

a) a first blank region (the region of the paper that allows a printed output to be printed, column 1, lines 40-45) for subsequent printing (image is being printed one after the other fig. 1; all paper, plates, or substrates inherently have a blank area that will subsequently have ink applied) of the content image (printed image, column 1, line 43) portion; and

b) a second region outside of the first blank region (trim area of the web (paper), column 2, lines 5-15) having one or more standard color bars (column 2, line 6) pre-printed thereon (the color bar that was printed on the paper before the image is being printed, e.g., the color bar that is printed with an OK color to be scanned later, column 7, lines 10-25).

**Regarding claim 2:** Seymour teaches wherein the second region further comprises one pre-printed standard color bar (the color bar that was printed on the

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paper before the image is being printed. e.g., the color bar that is printed with an OK color to be scanned later, column 7, lines 10-25), the second region having a blank area (the area that is not to be printed with test color bar, column 2, lines 5-15) adjacent (the color bars are adjacent to each other along the trim area of the paper, col. 2, lines 5-10) to the preprinted color bar for subsequent (fig. 1) printing of a second color bar (the test color bar, column 2, lines 5-10).

**Regarding claim 3:** Seymour teaches a hard proof that can be visually inspected to determine if the hard proof meets industry standards, the hard proof being a sheet of proofing paper (column 1, line 21) comprising:

- (a) a content image portion (printed image, column 1, line 43);
- (b) one or more standard first color bars (column 2, line 6) pre-printed on the sheet of proofing paper prior to printing of the content image portion thereon;
- (c) one or more second color bars (patches of standard primary colors, col. 2, lines 7-10) printed along with the content image portion and printed in a predefined relationship to the one or more first color bars (a patch to be a color bar and one or more patches in Seymour has a predefined relationship to the one color bar) so as to allow for visual inspection directly on the proofing paper using only the color bar image data of the first and second color bars, and without using any external color reference materials, wherein a visually discernable color match indicates that a proof which meets industry standards has been made and a visually discernable color mismatch indicates that a proof which meets industry standards has not been made.

**Regarding claim 4:** Seymour teaches wherein the first and second color bars are printed adjacent to each other (the color bars are adjacent to each other along the trim area of the paper, col. 2, lines 5-10).

**Regarding claim 5:** hard proof of claim 4 wherein the first and second color bars are selected so as to have identical color appearance (color bars may vary in their desired appearance, col. 2, lines 25-27) when imaged with their corresponding ICC profiles using a calibrated marking system.

**Regarding claim 6:** as best understood by the Examiner, Seymour teaches wherein the hard proof of claim 3 wherein one or more of the second color bars are printed over at least a portion of the one or more first color bars (the color bars are adjacent to each other along the trim area of the paper, col. 2, lines 5-10), wherein subtractive colors are used for the visual inspection.

**Regarding claim 7:** Seymour teaches wherein the hard proof of claim 6 wherein the first and second color bars have different color appearance (color bars may vary in their desired appearance, col. 2, lines 25-27) when imaged with their corresponding ICC profiles using a calibrated marking system.

**Regarding claim 8:** Seymour teaches wherein the content image portion and the one or more second color bars are part of a digital proof file (target image color values can be obtained from a TIFF file, col. 6, line 62 – col.7, line 6).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJL



KING Y. POON  
PRIMARY EXAMINER